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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/644,382	08/23/2000	Jason Goldberg	4905.P002	1511

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EXAMINER

BOCCIO, VINCENT F

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/644,382

Applicant(s)

GOLDBERG ET AL.

Examiner

Vincent F. Boccio

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4 & 5</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5, 9-12 and 19-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Butler et al. (US 2002/0007493).

Regarding claims 1, 3-4, Butler discloses and meets the limitations associated with a method comprising:

- receiving video content from a fixed storage media (page 5, col. 2, "the movie provided on DVD with the overlay files being downloaded from an internet source");
- receiving data content from a dynamic storage media (PC 14), wherein the dynamic storage media receives the data content (overlays) from a remote location (internet) through a network connection (page 4, col. 1, modem 138 or other, means to receive information from the internet, wherein the overlays are defined by HTML files);
- overlaying the data content onto the video content to generate combined content in a single window (screen) and displaying (PC 14) the combined content (Fig. 3, page 4, "video stream in conjunction with hyperlink overlays"), wherein the overlaying comprises removing background from the data content such that the overlaying of the data content onto the video is transparent (page 5, col. 1, "transparent overlay").

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Regarding claim 2 Butler further meets the limitations of

- a wireless connection (page 1, "terrestrial", "ancillary digital content", Fig. 1).

Regarding claim 5, the limitation of wherein the fixed media, being the DVD is deemed to be larger 4.7 gigabyte in view of the storage size of the storage media such, as the PCs volatile memory 54 (page 4).

Claims 9-12 are analyzed and discussed with respect to the claims above, but, recite additional limitations of wherein since Butler provides for a DVD, wherein as claimed the DVD represents high bandwidth, therefore, met by Butler, wherein low bandwidth is represented by the storage memory wherein the server can update the memory with overlays thru the network, based on page 5, col. 2, wherein the overlay files can be downloaded from an internet source.

Claims 19-23 are analyzed and disclosed with respect to the claims above, wherein further meets the limitation of machine readable medium with instructions for performing (met by PC 14, being a computer with program code, facilitating the method).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the

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obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 7 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. (US 2002/0007493).

Claims 7 and 25 are analyzed and disclosed with respect to the claim above, as applied fails to address the limitation of uploading system data periodically from the at least one device.

The examiner takes official notice it is well known to periodically upload from a device system data, therefore, it would have been obvious to one skilled in the art to periodically upload system data from at least one device.

5. Claims 6, 8, 24, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. (US 2002/0007493) in view of Jefferson et al. (US 5,712,994).

Regarding claims 6, 8, 24 and 26, Butler discloses transparent overlays, but, fails to disclose modifying content, being an overlay, wherein the received content overlay can be modified to include only data content, or to present an overlay with content only and a transparent background.

It is noted that the overlays are presented being already transparent, although the examiner takes official notice that it is obvious that overlays can be provided that are to be not transparent and wherein HTML code can be modified such as using CGI or other, by a user, as suggested by Butler.

Jefferson teaches in Fig. 6, wherein a user's system either creates or loads an overlay, wherein the user is provided with a means to edit the overlay as desired, wherein according to col. 5, wherein the overlay window can be made to appear transparent or to have a visual distinction by having a different background color, therefore, not transparent, considered to be a user's choice to decide how the overlay is presented on the screen, as taught by Jefferson.

Therefore, it would have been obvious to one skilled in the art to modify the combination by allowing a user to modify an overlay to provide or show only the content, wherein the background part of the window would be transparent, as taught by Jefferson.

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6. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. (US 2002/0007493) in view of Abgrall (US 6,401,202) and Nishio et al. (US 5,557,317).

Regarding claim 13, Butler meets the limitations of

- a local directory structure that includes at least one directory having at least one file that includes data content (page 4, col. 2, overlays .. provided in groups corresponding to a particular video stream or content data), wherein the server transmits at least one file from the at least one directory to the associated to the at least one device (transmitting overlay files or overlay content even provided in groups to a device);
- wherein a processor on the server having commands to retrieve the data coupled to the network and to store the data content into the at least one file (storage of content for a DVD stream on the PC, page 5, movie ... on DVD with overlay or content data being downloaded from an internet source).

{A} Butler fails to disclose a server having a local directory structure, wherein each directory is associated with a device and wherein a data base that includes system data that has been retrieved from the at least one device.

Abgrall teaches at col. 9, line 44-, wherein a profile manager obtains user and system profiles of the computer system 100, such as hardware, software installed at the computer, wherein this information is provided to server 22, which is used to match preferences and targets content data to users based on the system data (hardware/software), as taught by Nishio.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Butler by retrieving system data from a device, in order to provide content, based on the system information or to perform downloading of content, based on a received and analyzed user's profile, as taught by Abgrall.

{B} The combination as applied further fails to disclose wherein a processor on the server having commands to retrieve the data content from at least one remote server

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coupled to the network and to store the data content into the at least one file.

Nishio teaches in Fig. 1, wherein a processor (service node 110), based on a request (from a device subscriber terminal 120), to a server (since node 110, stores in video storage 35, the node meets the limitation of a server), having commands to retrieve the data content from at least one remote server (video provider 130, having video server 41), coupled to the network and to store the data content into the at least one file (video storage 35), as taught by Nishio.

Therefore, it would have been obvious to one skilled in the art to modify the combination by, based on a request from a device/subscriber, to a server to retrieve the data content from at least one remote server coupled to the network and to store the data content into the at least one file, as taught by Nishio.

{C} The combination as applied fails to disclose wherein the server is provided with at least one script being executed by a processor on the server, wherein the at least one script having commands to retrieve the data content or in other words, wherein the server has program script facilitating the retrieval of the overlays which can be provided in groups, associated with specific video streams, either from DVD media {different programs} or broadcast program or other programs provided on other type of media.

The examiner takes official notice that it is well known in the art that a server can be implemented with a script language to facilitate handling of requests to retrieve data content, as is well known in the art, therefore, it would have been obvious to one skilled in the art at the time of the invention to utilize script or a scripting language program to facilitate the handling of requests from user to a server, as is well known.

Claims 14-17, are analyzed and discussed with respect to the claims above, wherein as applied the combination provides for scripts at the server to handle requests, but, as applied fails to address CGI or common gateway interface scripts.

The examiner takes official notice that CGI interface scripts are well known and obvious to one skilled in the

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art, to utilize at least one script being CGI type interface scripts, as is well known to those skilled in the art.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Butler et al. (US 2002/0007493), Abgrall (US 6,401,202) and Nishio et al. (US 5,557,317) and further in view of Jefferson et al. (US 5,712,994).

Regarding claim 18, Butler discloses transparent overlays, but, fails to disclose modifying content, being an overlay, wherein the received content overlay can be modified to include only data content, or to present an overlay with content only and a transparent background.

It is noted that the overlays are presented being already transparent, although the examiner takes official notice that it is obvious that overlays can be provided that are not transparent.

Jefferson teaches in Fig. 6, wherein a user's system either creates or loads an overlay, wherein the user is provided with a means to edit the overlay as desired, wherein according to col. 5, wherein the overlay window can be made to appear transparent or to have a visual distinction by having a different background color, therefore, not transparent, considered to be a user's choice to decide how the overlay is presented on the screen, as taught by Jefferson.

Therefore, it would have been obvious to one skilled in the art to modify the combination by allowing a user to modify an overlay to provide or show only the content, wherein the background part of the window would be transparent, as taught by Jefferson.

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Contact Fax Information

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communication intended for entry)

or:

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).


Contact Information

1. Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Thursday, 8:00 AM to 5:00 PM Vincent F. Boccio (703) 306-3022.

If any attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Andy Christensen (703) 308-9644.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vincent
4/2/04


VINCENT BOCCIO
PRIMARY EXAMINER